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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,916	11/27/2001	Jill Susan Coomber	000545.00006	7406

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EXAMINER

THAI, CANG G

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 02/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/994,916	Applicant(s) COOMBER ET AL.	
	Examiner Cang G. Thai	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/27/2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two prong test of:

1. whether the invention is within the technological arts; and
2. whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere idea in the abstract (i.e. abstract ideas, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e. physical sciences as opposed to social sciences for example), and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, use or advance the technological arts.

In the present case, Claim 1 is directed to "a method of measuring the effectiveness of at least one of public relation and marketing effort, said method comprising the steps of:

- i) defining a message array comprising a record relating to at least one message which it is desired to promote and a record of reports of the message,

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- ii) defining a deliverable array comprising record relating to at least one verifiable event selected from a group consisting of verifiable activities and verifiable outcomes and a record relating to an outcome deliverable,
- iii) conducting at least one of public relations and marketing,
- iv) monitoring for the at least one message,
- v) updating the message array in response to detection of the at least one message,
- vi) monitoring for an outcome deliverable, and
- vii) updating said deliverable array in response to detection of an outcome deliverable."

In the present case, Claim 1 does not require any technology. The recited steps of measuring the effectiveness of public relations does not apply, involve, use, or advance the technological arts since all of the recited steps can be done with no technology at all. The recited steps only constitute an idea for measuring the effectiveness of public relations.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful (specific utility), concrete (repeatability and/or implementation without undue experimentation), and tangible (a real or actual affect) result.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

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4. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 1 recites the limitation of "array" and "message" in "measuring the effectiveness". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-16 are rejected under 35 U.S.C. 102(e) as being anticipated by U. S.

Patent No. 6,839,681 (HOTZ).

As for Claim 1, HOTZ discloses a method of measuring the effectiveness of at least one of public relations and marketing effort, said method comprising the steps of

- i) defining a message array comprising a record relating to at least one message which it is desired to promote and a record of reports of the message {Column 9, Lines 58-59, wherein this reads over "selecting the desired parameters the user can then instantiate by click search button 311},

- ii) defining a deliverable array comprising record relating to at least one verifiable event selected from a group consisting of verifiable activities and verifiable outcomes and a record relating to an outcome deliverable {Column 9, Lines 60-61, wherein this reads over "a user could specify a custom search for all references regarding a particular brand},
- iii) conducting at least one of public relations and marketing {Column 9, Lines 61-62, wherein this reads over "all references appearing in a particular magazine},
- iv) monitoring for the at least one message {Column 9, Lines 62-65, wherein this reads over "the user will be also be able to view a report wherein the references are ranked according to the value of a selected index, such as Publicity Value},
- v) updating the message array in response to detection of the at least one message {Column 10, Lines 51-54, wherein this reads over "the user may restrict the search results based on the Issue/Air date of the editorials Opinions include 1-30 days old, 1-90 days old, or a date range entered by the user},
- vi) monitoring for an outcome deliverable {Column 11, Lines 24-25, wherein this reads over "the user will be presented with a plurality of archived reports for the proceeding months}, and
- vii) updating said deliverable array in response to detection of an outcome deliverable {Column 11, Lines 25-27, wherein this reads over "the user

can then chose to view either a summary report 150 or a List Report 151”}.

As for Claim 2, HOTZ discloses the method of claim 1 wherein said record of reports of the message further comprise a record of a date of publication of the message {Column 11, Lines 47-51, wherein this reads over “the date range and media types are only parameters, the report will be generated for all the given company’s designated brands and all their designated competing brands, with no market quality factor or keyword restrictions}.

As for Claim 3, HOTZ discloses the method of claim 1 wherein a target audience array is associated with the message array, the target audience array correlating each of a plurality of messages with target audiences {Column 11, Lines 55-57, wherein this reads over “the Advanced Competitive Analysis provides the user with additional parameters with which to limit the analysis report}.

As for Claim 4, HOTZ discloses the method of claim 1 wherein the record of the outcome deliverable includes a record of the date of the outcome deliverable {Column 11, Lines 65-66, wherein this reads over “the reports available to the user are Complete Listing Report 153}. It appears that the date of the outcome deliverable would also be in the Complete Listing Report 153.

As for Claim 5, HOTZ discloses the method of claim 1 wherein at least one metric array is provided said metric array providing an at least semi-quantitative measure of records of reports of the message {Column 13, Lines 34-37, wherein this reads over “the reports available to the user from the present invention as previously

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described therefore provide a user with data regarding advertising, public relations and sales from sole source”}.

As for Claim 6, HOTZ discloses the method of claim 5 wherein a metric array comprises a measure of the length of the report of the message {Column 13, Lines 40-42, wherein this reads over “the user can customize and filter the report results in order to view only that data having the most significance to that user}.

As for Claim 7, HOTZ discloses the method of claim 5 wherein a metric array comprises a measure of the source of the reported message {Column 14, Lines 26-28; wherein this reads over “generating reports and analysis for management meetings, presentations and strategic decision making”}. It appears this step is the source of the reported message.

As for Claim 8, HOTZ discloses the method of claim 5 wherein a metric array comprises a measure of the tone of the reported message {Column 14, Lines 28-33, wherein this reads over “creating regular summaries and reports for key individuals and groups (sales, celebrity, corporate, retail), centralize global news coverage for users worldwide, gaining intermediate understanding editorial coverage and value returned to company, measuring productivity for management to support future activities”}.

As for Claim 9, HOTZ discloses a system for measuring the effectiveness of at least one of public relations and marketing effort, said system comprising

- i) a message array comprising a record relating to at least one message which it is desired to promote and a record of reports of the message {See Fig. 4, Element 402},

- ii) a deliverable array comprising record relating to at least one verifiable event selected from the group consisting of verifiable activities and verifiable outcomes and a record relating to ml outcome deliverable {See Fig. 4, Element 403},
- iii) a first monitor monitoring for the at least one message relating from public relations or marketing {See Fig. 4, Element 406},
- iv) a first updater updating the message array in response to detection of the at least one message {See Fig. 4, Element 410},
- v) a second monitor monitoring for an outcome deliverables {See Fig. 4, Element 411}, and
- vi) a second updater updating said deliverable array in response to detection of an outcome deliverable {See Fig. 4, Element 416}.

As for Claim 10, HOTZ discloses the system of claim 9 wherein said record of reports of the message further comprise a record of a date of publication of the message {See Fig. 4, Element 405}.

As for Claim 11, HOTZ discloses the system of claim 9 wherein a target audience array is associated with the message array, the target audience array correlating each of a plurality of messages with target audiences {See Fig. 4, Element 404}.

As for Claim 12, HOTZ discloses the system of claim 9 wherein the record of the outcome deliverable includes a record of the date of the outcome deliverable {See Fig. 4, Element 418}.

As for Claim 13, HOTZ discloses the system of claim 9 wherein at least one metric array is provided said metric array providing an at least semi-quantitative measure of records of reports of the message {See Fig. 4, Element 406}.

As for Claim 14, HOTZ discloses the system of claim 13 wherein a metric array comprises a measure of the length of the report of the message {See Fig. 4, Element 410}.

As for Claim 15, HOTZ discloses the system of claim 13 wherein a metric array comprises a measure of the source of the reported message {See Fig. 4, Element 409}.

As for Claim 16, HOTZ discloses the system of claim 13 wherein a metric array comprises a measure of the tone of the reported message {See Fig. 4, Element 415}.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

I. U.S. Patent:

- 1) U.S. Patent No. 5,724,262 (GHAHRAMANI) is cited to teach the method for measuring the usability of a system and for task analysis and re-engineering,
- 2) U.S. Patent No. 6,007,340 (MORREL-SAMUELS) is cited to teach the method and system for measuring leadership effectiveness,
- 3) U.S. Patent No. 5,365,425 (TORMA ET AL.) is cited to teach the method and system for measuring management effectiveness,

- 4) U.S. Patent No. 6,249,282 (SUTCLIFFE ET AL.) is cited to teach the method and apparatus for matching registered profiles, and
- 5) U.S. Patent Application Publication No. 2002/0111847 (SMITH, II) is cited to teach the system and method for calculating a marketing appearance frequency measurement.

II. Non-Patent Literature:

- 1) Cain and Oppenheimer, MDS, "The misconception of using floating patterns as an accurate means of measuring the contents of metered-dose inhaler devices", November 2001, Annals of Allergy, Ashma, and Immunology, Health & Medical Complete, Page 417.
- 2) Pepin, Dower, and Benoit, "The role of measurement error on the interpretation of otolith increment width in the study of growth in larval fish", November 2001, Canadian Journal of Fisheries and Aquatic Sciences, Research Library, Page 2204.
- 3) Anonymous, "Operational risk", November 2001, Norges Bank Financial Stability, ABI/INFORM Global, Page 23.
- 4) Sheila Leatherman, "Measuring up: Performance indicators for better healthcare", November 2001, Organisation for Economic Cooperation and Development, The OECD Observer, ABI/INFORM Global, Page 18.

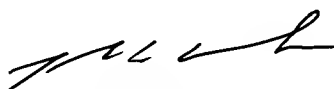
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cang (James) G. Thai whose telephone number is (703) 305-0553. The examiner can normally be reached on 6:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CGT
2/1/2005


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